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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,164	02/16/2001	Mark G. Guedri	1075.39554X00	8749
20457	7590	01/18/2005	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889			NELSON, FREDA ANN	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/784,164

Applicant(s)

GUEDRI ET AL.

Examiner

Freda Nelson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 28-30 is/are rejected.
- 7) ☒ Claim(s) 25-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/16/01 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is in response to a letter for a patent filed February 16, 2001 in which claims 1-30 were presented for examination. Claims 1-30 are pending.

#### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 02/16/01/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. A copy of PTO-1449 is attached hereto.

#### ***Claim Objections***

2. Claims 25-27 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

#### ***Claim Rejections - 35 USC § 101***

3. Claims 1-24 and 28-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-24 and 28-30 only recite an abstract idea. The recited steps of merely determining from at least one information source providing information about sales of private businesses and determining an identification of at least one shareholder of the at least one private business who at least potentially will receive from the sale compensation exceeding the threshold shareholder compensation value does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to select an insurance policy over another.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-24 and 28-30 are deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 16-23, 28, and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis (US PG Pub.2004/0162772).

5. In claims 1-3, Lewis discloses that the invention proactively alerts users and other applications when a situation occurs that warrants immediate attention (paragraph 0033). Lewis further discloses that alerts are sent to users and applications when prices change in excess of pre-set change tolerances, and when a corporate action is announced that is voluntary (e.g., a tender offer) in nature that requires a choice to be made by the owner of the security for which the corporate action was announced (paragraph 0131). Lewis still further discloses that the Alert Notification Server, 160, also uses the Calculation Server, FIG. 4, to calculate the amount of the entitlement resulting from a corporate action (e.g., a stock split) and formulates and sends a transaction message to the Accounting Information Server from which the Accounting Information Server updates the positions that are entitled to the proceeds from the corporate action (paragraph 0131). The fact that the selected time is after the announced or completed transaction is nonfunctional descriptive matter. It is not functional interrelated with the useful acts of the claimed invention and thus will not serve as limitation. The steps of identifying any shareholder or the at least one private

business determined to be at least potentially receiving compensation resulting from a transaction which exceeds a threshold would be performed the same regardless of whether the selected time is after the announced transaction or completed transaction. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1385, 217 USPQ 401,404 (Fed Cir. 1983); *In re Lowry*, 32 F 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include selected time limitations because such data does not functionally relate to the steps in the method claim and does not patentably distinguish the claimed invention.

6. In claims 4-9, Lewis does not disclose that the value exceeding the threshold is determined from publicly reported transaction terms of the proposed announced transaction or completed transaction of the at least one private business, however it is an old and well-known established business principle that the value exceeding the threshold value is determined from publicly reported terms. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the implement Lewis's system to include publicly reported terms to get the full benefit of the alert notification feature.

7. In claims 16-23, Lewis discloses that the Customer/Counterparty Information server essentially operates the same way that the Market Data Information Server operates, only on messages that contain updates to customer and counterparty data. Such data includes name, address, and instructions (e.g., investment, trading, cash

sweep, and settlement instructions) for processing the transactions of the customer or counterparty, and for how to provide the customer or counterparty information (e.g., reporting instructions, on-line authorization/subscription) paragraph 0134)).

8. In claims 28 and 30, Lewis discloses that the database makes both the data and the information available for simultaneous access by, and proactive electronic distribution to the numerous customers, employees, and counterparties of the organization according to select and individualized inquiry and publish criteria. Importantly, the system is designed so that inputs can be received from a myriad of different transaction origination and settlement systems, market data vendor systems, and customer/counterparty systems, each having its own disparate data record formats (paragraph 0071).

9. Claims 10-15, 24 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis (US PG Pub.2004/0162772) in view of Beaulieu et al. (Patent Number 5,502,637).

10. In claims 10-12 and 29, Lewis does not disclose that the value exceeding the threshold value is estimated from data obtained from at least one source pertaining to other private businesses or national government filings. Beaulieu et al. disclose a system for notifying a user/investor of current investment research information and reports of interest to the user/investor and for providing access to the information and reports from the user/investor location in the broker/author's original form and in real time (col. 1, lines 7-15). Beaulieu et al. disclose that by "investment research" is meant

reports, memoranda, notes, promotional materials, annual reports, earnings reports, government filings, and other information concerning a particular security, security issuer, class of securities, or industry, which is generated by brokerage firms, security issuers, market watchers and others, which is relevant to an investment decision (col. 4, lines 26-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Lewis to include the feature of Beaulieu et al. in order to receive financial data from a variety of information sources. The fact that government filings are with the SEC is nonfunctional descriptive matter. It is not functional interrelated with the useful acts of the claimed invention and thus will not serve as limitation. The steps of identifying any shareholder or the at least one private business determined to be at least potentially receiving compensation resulting from a transaction which exceeds a threshold would be performed the same regardless of whether governmental filings are with the SEC. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1385, 217 USPQ 401,404 (Fed Cir. 1983); *In re Lowry*, 32 F 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include SEC limitation because such data does not functionally relate to the steps in the method claim and does not patentably distinguish the claimed invention.

11. In claims 13-15 and 24, Beaulieu et al. disclose that by "investment research" is meant reports, memoranda, notes, promotional materials, annual reports, earnings reports, government filings, and other information concerning a particular security,



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security issuer, class of securities, or industry, which is generated by brokerage firms, security issuers, market watchers and others, which is relevant to an investment decision (col. 4, lines 26-32). The fact that the at least one source pertaining to other private business stores data related to a transaction value pf other businesses representative of the value of the at least one private business from which the sale value is extrapolated is nonfunctional descriptive matter. It is not functional interrelated with the useful acts of the claimed invention and thus will not serve as limitation. The steps of identifying any shareholder or the at least one private business determined to be at least potentially receiving compensation resulting from a transaction which exceeds a threshold would be performed the same regardless of whether the at least one source pertaining to other private business stores data related to a transaction value pf other businesses representative of the value of the at least one private business from which the sale value is extrapolated. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1385, 217 USPQ 401,404 (Fed Cir. 1983); *In re Lowry*, 32 F 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the limitation of the at least one source pertaining to private businesses because such data does not functionally relate to the steps in the method claim and does not patentably distinguish the claimed invention.

***Conclusion***

12. The examiner has cited prior art of interest, for example:

1) Dalby et al. (US PG Pub. 2002/0057284), which disclose methods and systems for delivering announcements to users of an information system.

2) Kane et al. (Patent Number 6,389,429), which disclose a system and method for generating a target database from one or more source databases.

3) Karp et al. (US PG Pub. 2003/0154171), which disclose an apparatus and method for selling personal information.

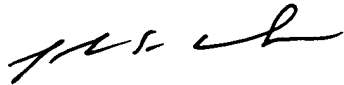
4) Gannett.com, which discloses that a quarterly dividend of 20 cents per share to shareholders.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda Nelson whose telephone number is (703) 305-0261. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 3629



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